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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,641	07/31/2001	Yuji Shinohara	325772026100	1557

25227 7590 04/27/2006

MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 300
MCLEAN, VA 22102

EXAMINER

POLLACK, MELVIN H

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,641

Applicant(s)

SHINOHARA ET AL.

Examiner

Melvin H. Pollack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> . |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 06 February 2006 have been fully considered but they are not persuasive. An analysis of the arguments is provided below.
2. The new title is accepted, and the related rejection is withdrawn.
3. In response to applicant's argument that Gilbert is nonanalogous art (P. 7, lines 9-13), it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Gilbert teaches that "the embedded format commands are recognized for automatically generating a separate, properly formatted electronic mail message for each specific recipient (col. 1, lines 59-61)." This is similar to the stated objective of the instant application, a method and system "capable of extracting necessary parts of electronic files for each receiver and sending the extracted data to the receiver, in data delivery by e-mail (P. 2, Para. 6)," in that it individualizes e-mail messages for the specified purpose of at least highlighting the sections necessary for each receiver. That Gilbert does not delete other portions while the instant application does is irrelevant for determining whether Gilbert is analogous; the cited art meets the tests of being in the field of the applicant's endeavor (customized e-mail messages), and reasonably pertinent to the problem (providing receivers with easy-to-find necessary sections). Therefore, Gilbert is analogous art.
4. In response to applicant's argument that Gilbert operates for a wholly different purpose (P. 7, line 13), a recitation of the intended use of the claimed invention must result in a structural

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difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In any event, the above shows that the purpose is the same.

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "searching for text in document files (P. 7, lines 18-20)") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). There is no claim limitation stating that a keyword is used to search a document, nor is such a limitation supported in the specification.

6. Applicant alleges that Gilbert's text formatting code is not equivalent to the keyword cited in the application (P. 7, lines 18-22). According to the instant application, "The data extracting unit 21 reads the file from the storing unit 24, and searches the file for a character string (keyword) corresponding to each receiver. The data extracting unit 21 extracts data that contains the keyword (Pp. 6-7, Para 32)." From this, the examiner interprets the applicants' keyword definition to be not a search term utilized by a user to find a portion in a file. Rather, the keyword acts as a text-based delimiter used as a key, wherein an email individualization program 12, during the individualization process, searches for words its recognizes as key markers, and performs a set of instructions based upon finding such a marker. Whether that instruction set is to change the font color or to delete any words not between or surrounding the key marker is irrelevant. That these words be surrounded by brackets, or words in English, are also irrelevant.

7. Gilbert teaches that the document file includes text phrases (col. 4, line 60). Gilbert further teaches that “when an embedded processing code is found within a message by the software (after searching for such embedded processing codes), the software looks for a reference corresponding to a particular recipient which has been provided by the originating user of the message. If an embedded processing code is not associated with any known recipient, then the embedded text format codes are ignored (col. 8, lines 10-16).” In other words, the software searches the stored e-mail file for certain character strings, and performs operations on text near the character string while ignoring all other text. Therefore, Gilbert fulfills the functionality of the instant application, both in the specification and as claimed, as regards accepting and utilizing keywords.

8. In response to applicant's argument that Gilbert cannot be combined with Kohler (P. 8, lines 1-6), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

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1992). In this case, both Gilbert and Kohler are drawn to e-mail individualization for the purpose of providing a recipient with necessary information, and indicating to the recipient the necessary items, without writing more than one e-mail. One of ordinary skill in the art would recognize the bandwidth and storage waste of Gilbert to send unnecessary portions to a recipient, to say nothing of the potential confusion wherein a recipient may consider bolded and non-bolded portions to be relevant to him or her. Further, Gilbert teaches the ability to modify the font color, and one of ordinary skill in the art would recognize that the font color of unnecessary items may equal the font color of the background. Kohler teaches the above issues, as cited in the previous office action, and further teaches a method and system for correcting these deficiencies. Therefore, there is sufficient motivation to combine, wherein Kohler is the secondary reference.

10. The applicant argues that Gilbert cannot be combined with Kohler because neither reference teaches a keyword (P. 8, lines 1-5). The examiner is unclear in how to respond. The applicant is required to specify why he believes the combination to be non-obvious, such as lack of motivation, destruction of primary reference, and so forth. The applicant must further provide evidence as to why said combination is non-obvious.

11. Therefore, the rejection stands for the reasons above, and is made final.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-4, 11, 12, 15, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (6,529,942), and further in view of Kohler (6,192,396).

14. For claims 1, 12, 15, 18, and 19, Gilbert teaches a data processing method and system (abstract; col. 1, line 1 – col. 2, line 30) comprising:

- a. Accepting a keyword from a user (col. 7, lines 65 – col. 8, line 20; the keyword is the text-based embedded code used to tag text blocks);
- b. Accepting identification of a document file from the user (col. 4, lines 57-60; the document is an e-mail message being generated);
- c. Accepting a mail address from the user, the mail address corresponding to the accepted keyword (col. 5, lines 5-25; tags associated with email addresses);
- d. Modifying data corresponding to the keyword, from the document file (col. 5, lines 50-55; col. 7, lines 45-65); and
- e. Attaching the modified data to an e-mail message (col. 5, lines 25-45);
- f. Wherein the user sends the e-mail message to the mail address (Fig. 2, #76).

15. Gilbert does not expressly disclose extracting data corresponding to the keyword, from the document file, or attaching the extracted data to an e-mail message. Kohler teaches a method and system (abstract) for creating recipient-specific e-mail messages (col. 1, line 1 – col. 2, line 67), the user generating and sending e-mails (col. 3, lines 63-65), in which documents are identified (col. 5, lines 10-20), and recipients identified (col. 5, line 65 – col. 6, line 20) such that data corresponding to keywords is not only modified but extracted such that only some recipients receive said contents (Fig. 10; col. 6, line 45 – col. 7, line 25; col. 8, lines 45-55). At the time the invention was made, one of ordinary skill in the art would have added Kohler extraction methods

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to Gilbert in order to further Gilbert's goal of individualized messaging (Kohler, col. 1, lines 35-45) and to ensure Gilbert's further goal of ensuring that recipients better determine the messages meant for them (Gilbert, col. 1, lines 10-40).

16. Claim 17 is drawn to the limitations in claim 12. Claim 17 adds the limitations of a plurality of mail addresses and corresponding keywords, such that each recipient gets a different attachment. Gilbert teaches the limitation set (Fig. 6). Therefore, since claim 12 is rejected, claim 17 is also rejected for the reasons above.

17. For claim 2, Gilbert teaches that the data extracting step extracts data that includes the keyword, as the data corresponding to the keyword (Fig. 5).

18. For claim 3, Gilbert teaches that the data extracting step extracts a paragraph corresponding to the keyword, as the data corresponding to the keyword (Fig. 6).

19. For claim 4, Gilbert teaches that the document file is an HTML file, and the paragraph data is data that begins after a paragraph start tag and ends before a paragraph end tag (Fig. 5; col. 6, line 40 – col. 7, line 25).

20. For claim 11, Gilbert teaches that the e-mail message is an HTML-format message (Fig. 5).

21. For claim 20, Gilbert teaches that the extracted data includes a part of a main body of the document file, and the part of the main body of the document file includes the keyword (Fig. 5).

22. Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert and Kohler as applied to claim 1 above, and further in view of Christensen et al. (6,347,320).

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23. For claim 5, Gilbert and Kohler do not expressly disclose that the data extracting step extracts a row corresponding to the keyword from a table included in the document file, as the data corresponding to the keyword. Christensen teaches a method and system (abstract) of searching within HTML files (col. 1, line 1 – col. 4, line 16) in which the included text may be between any two tags (col. 6, line 63 – col. 8, line 25), including within text paragraphs (Fig. 5) and within table row tags (col. 8, lines 8-12). At the time the invention was made, one of ordinary skill in the art would have used Christensen's table method to modify tables in Gilbert and Kohler files in order to allow for more complex pages (col. 2, lines 15-25).

24. For claim 6, Gilbert and Kohler do not expressly disclose that the document file is an HTML file, and the row is data that begins after a table row start tag and ends before a table row end tag. Christensen teaches this limitation (col. 7, lines 1-15). At the time the invention was made, one of ordinary skill in the art would have used Christensen's table method to modify tables in Gilbert and Kohler files in order to allow for more complex pages (col. 2, lines 15-25).

25. For claim 7, Gilbert and Kohler do not expressly disclose that the data extracting step extracts a column corresponding to the keyword from a table included in the document file, as the data corresponding to the keyword. Christensen teaches this limitation (col. 8, lines 8-12). At the time the invention was made, one of ordinary skill in the art would have used Christensen's table method to modify tables in Gilbert and Kohler files in order to allow for more complex pages (col. 2, lines 15-25).

26. For claim 8, Gilbert and Kohler do not expressly disclose that the document file is an HTML file, and the column is made up of one or more sets of data that each begin after a table data cell start tag and end before a table data cell end tag. Christensen teaches this limitation

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(col. 7, lines 1-15). At the time the invention was made, one of ordinary skill in the art would have used Christensen's table method to modify tables in Gilbert and Kohler files in order to allow for more complex pages (col. 2, lines 15-25).

27. For claim 9, Gilbert and Kohler do not expressly disclose that the data extracting step extracts a cell corresponding to the keyword from a table included in the document file, as the data corresponding to the keyword. Christensen teaches this limitation (col. 8, lines 8-12). At the time the invention was made, one of ordinary skill in the art would have used Christensen's table method to modify tables in Gilbert and Kohler files in order to allow for more complex pages (col. 2, lines 15-25).

28. For claim 10, Gilbert and Kohler do not expressly disclose that the document file is an HTML file, and the cell is data that begins after a table data cell start tag and ends before a table data cell end tag. Christensen teaches this limitation (col. 7, lines 1-15). At the time the invention was made, one of ordinary skill in the art would have used Christensen's table method to modify tables in Gilbert and Kohler files in order to allow for more complex pages (col. 2, lines 15-25).

Conclusion

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP
21 April 2006


JASON CARDONE
SUPERVISORY PATENT EXAMINER